No. 99-2068

Supreme Court, U.S.
FILED
JUL 24 2000
CLERK

In The

Supreme Court of the United States

COLLECTIBLES INC., d/b/a Collectibles Records,

Petitioner,

vs.

LEONARD BROWN; WALTER PRICE; PETE MAYES; JAMES NELSON; JOE HUGHES, a/k/a Joe "Guitar" Hughes; RAYFIELD JACKSON, a/k/a "Houston Guitar Slim"; FREDDIE COLLINS, a/k/a "Big Roger" Collins; FALIETA GREEN as Independent Executrix of the Estate of Clarence Green; THOMAS DARDAR, a/k/a Tommy Dardar; ROBBYE R. WALDRON for the Estate of Alfred R. Bettis a/k/a "Big Al" Bettis; DEBRA L. NICKERSON as heir to the Estate of Weldon Bonner a/k/a "Juke Box Bonner"; LIZETTE COBB as heir to the Estate of Arnett Cobb; and KINNEY ABAIR,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Fifth Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

LAW OFFICES OF DAVID W. SHOWALTER, P.C.
DAVID W. SHOWALTER
Counsel of Record
CHARLOTTE FLOECK
5231 Bellaire Boulevard
Bellaire, Texas 77401-3901
(713) 660-0491

Attorneys for Respondents

July 24, 2000

COCKLE LAW BRIEF PRINTING CO., (800) 225-6964
OR CALL COLLECT (402) 342-2831

16 pp

QUESTION PRESENTED

Whether the Fifth Circuit properly refused Petitioner's claim that Petitioner should be allowed to misappropriate musicians' names, images and likenesses when Petitioner was found liable for copyright infringement of words and music of various songs when the copyrighted material did not include names, images and likenesses.

LIST OF PARTIES

1. Kinney Abair, Respondent
2. Al Bettis, Respondent
3. Leonard "Low Down" Brown, Respondent
4. Lizette C. Cobb, Respondent
5. Freddie Collins, p/k/a Big Roger Collins, Respondent
6. Thomas Dardar, Respondent
7. Lee J. Frazier, p/k/a Skipper Lee Frazier, Respondent
8. Falieta Green, on behalf of Clarence Green, Respondent
9. Joe "Guitar" Hughes, Respondent
10. Rayfield Jackson, Respondent
11. Pete Mayes, Respondent
12. James T. Nelson, p/k/a T-99, Respondent
13. Debra Nickerson, on behalf of Weldon Bonner, Respondent
14. Clarence C. Parker, Respondent
15. Walter T. Price "Big Walter", Respondent

TABLE OF CONTENTS

Page

STATEMENT OF THE CASE 1

REASONS FOR DENYING THE WRIT 4

A. THE FIFTH CIRCUIT'S DECISION IS SIGNIFICANT IN THAT IT REQUIRES A WRONGDOER TO PAY A MODEST AMOUNT OF DAMAGES. OTHERWISE, THE DECISION HAS NO SIGNIFICANCE IN FEDERAL JURISPRUDENCE 4

B. NO CONFLICT EXISTS AMONG THE FEDERAL CIRCUIT COURTS OF APPEALS BECAUSE MISAPPROPRIATION IS A DISTINCT AND SEPARATE CAUSE OF ACTION OUTSIDE OF THE SUBJECT MATTER CONTEMPLATED BY SECTION 106 OF THE COPYRIGHT ACT 6

CONCLUSION 10

TABLE OF AUTHORITIES

Page

CASES:

Allison v. Vintage Sports Plaques, 136 F.3d 1443 (11th Cir. 1998) 7

Baltimore Orioles Inc. v. Major League Baseball Players Ass'n, 805 F.2d 663 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987) 6, 7

Daboub v. Gibbons, 42 F.3d 285 (5th Cir. 1995) 8

King v. Ames, 179 F.3d 370 (5th Cir. 1999) 5

Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988) 8

Moore v. Big Picture Co., 828 F.2d 270 (5th Cir. 1987) 5

Waits v. Frito-Lay, 978 F.2d 460 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080 (1993) 5

STATUTES:

17 U.S.C. § 102 ..... 7, 8

17 U.S.C. § 106 9

17 U.S.C. § 301 4

STATEMENT OF THE CASE

Respondents direct the court to the facts as outlined in the opinion of the court of appeals, Pet. App. A1-2 through A1-4, but Respondents add the following.

For the most part, Respondents are Houston area blues musicians, elderly, unsophisticated and uneducated. The trial transcript documents a sordid history of overreaching, misrepresentation and outright misappropriation by Houston area "blues producer" Roy C. Ames. Ames teamed up with Collectibles Record Company to manufacture and sell over $250,000 of stolen recordings. Ames is also a judgment debtor to Respondents. Ames claims to be insolvent and has not appealed the decision of the Fifth Circuit which is adverse to him. Despite extensive dealings with Ames, Petitioner claims to be innocent of Ames' widely known unsavory business practices. Throughout the history of this dispute, Collectibles has taken the position that it is excused from ascertaining whether Ames, its Licensor, actually had the rights he claimed to have to exploit people's recordings or musician's names, images or likenesses because it would be burdensome to a large company that sells so much music. In essence, Collectibles reasons, it is entitled to take advantage of people because it is able to do it on such a broad scale, rather than depriving a few people of their rights one at a time. Collectibles never asked to see Ames' alleged contracts with the Respondents and never made an effort to contact any of the musicians whose musical compositions, names and images Collectibles exploited.

Collectibles is a record label that distributes and sells musical recordings. The words and music of the recordings are the only aspects of Collectibles' product which involved copyrights in this suit. Copyrights of the *words and music* comprised the entire basis of Respondents' copyright claim. Respondents' copyright claims did not involve their *names, reputations or images*. In fact, the Copyright Act does not contemplate extension of the protection of the Act to these separate and distinct rights. Because copyrights in musical recordings protect only the *words and music* of the recording, it is critical to enforce state laws which protect an individual against the unauthorized exploitation of a person's *name, reputation or likeness*. Pet. 3.

Collectibles recognizes that these rights are distinct and arise from separate sources. That is the reason it included *separate* contract provisions in its agreements with Ames that dealt *separately* with the copyrights being licensed and *separately* with the right to use the names, photographs, likenesses and biographical material of the musicians whose compositions were being exploited. Pet. 3.

Like the unauthorized use of a brand name to sell counterfeit products, Collectibles used the Respondents' names, images and reputations without permission to market the counterfeit products. These rights have a recognized value that is *not* the same as a copyright in the words and music of a song. The record demonstrated the value of these rights separate and apart from the value of a song. These rights have a character that stand separately on their own merits. The quantum and calculation of damages is different, there are different standards for

imposing liability, there are different limitations periods, there are different acts which are prohibited, there are different sources of rights, there are different contract provisions relating to them, they are subject to different principles governing transfer and licensing, they are embodied and depicted in different ways, and are communicated and characterized in different ways. The rights are not the same. If Collectibles wants to misappropriate these rights in Texas, California and New York, it must be prepared to be liable under the laws of these states.

Collectibles continues to advance the same tired arguments that failed with the trial court and with the Fifth Circuit. Respondents are the ones most tired of the delay in receiving compensation for the unauthorized use of their names, images and reputations to market musical recordings. Collectibles sold over $250,000 retail value of recordings before they were stopped by Respondents. Respondents have never received a penny from Collectibles. The judgment against Collectibles is only $1,800 for copyright infringement and $27,000 for misappropriation. One has to wonder what Collectibles' real motivation is. Perhaps Collectibles hopes the aging Respondents will die before Collectibles has to pay the judgment.

The trial and appellate courts were not persuaded by Collectibles' arguments. Collectibles has been adjudicated liable for the violation of these musicians' copyrights. Now Collectibles wants a free pass for its unauthorized misappropriation of these musicians' reputations arguing that one wrong exculpates them from a multitude of other wrongs. The Court should decline Collectibles' invitation to become a business partner in this scheme of malfeasance.

REASONS FOR DENYING THE WRIT

The sole question presented by the Petition is whether the Copyright Act preempts a state law claim for misappropriation of name and likeness. Petitioner argues that the Fifth Circuit's opinion improperly holds that the unauthorized appropriation of one's name, image or likeness, as a species of the right of privacy or publicity, is not preempted by the Copyright Act as the rights sought to be protected do not fall into the subject matter granted copyright protection under 17 U.S.C. § 301.

The ruling does not conflict with the Copyright Act. This case has no far-reaching implications. State common law claims for misappropriation of name and likeness and right of publicity are separate and distinct causes of action which can remain intact without threatening the uniform systems of rights and remedies the Copyright Act was designed to provide. The Fifth Circuit's ruling was proper in all respects and Respondents respectfully urge this Honorable Court to deny the Petition for Writ of Certiorari.

A. THE FIFTH CIRCUIT'S DECISION IS SIGNIFICANT IN THAT IT REQUIRES A WRONGDOER TO PAY A MODEST AMOUNT OF DAMAGES. OTHERWISE, THE DECISION HAS NO SIGNIFICANCE IN FEDERAL JURISPRUDENCE.

Collectibles ludicrously argues that the Fifth Circuit decision conflicts with the preemptive intent of the Copyright Act, creating a legal twilight zone when a plaintiff brings a cause of action for misappropriation. Petitioner

reasons that doing one type of damage to Respondents excuses Petitioner's other illegal conduct.

This is not the first case Collectibles and its accomplice Ames have lost on the preemption v. misappropriation issue. In *King v. Ames*, 179 F.3d 370 (5th Cir. 1999), these same parties were held liable to the heirs of late great blues musician Freddy King. In that case the Plaintiff was intimidated into dismissing her appeal against Collectibles because she could not pay court costs arising from another aspect of the judgment and consequently Collectibles escaped the liability for misappropriation which was later upheld by the Fifth Circuit.

The protection provided by the Copyright Act is totally different than the protection offered by the state laws prohibiting misappropriation. Misappropriation is an elemental concept of equity. You do not take what does not belong to you. Conversely, the Copyright Act creates a statutory scheme that limits exploitation of certain intangible ideas that have been fixed in tangible form in certain instances of use.

Misappropriation has been characterized as a species of the right of publicity or of privacy. *Moore v. Big Picture Co.*, 828 F.2d 270, 275 (5th Cir. 1987). The right of publicity is the right of a person whose identity has commercial value – most often a celebrity – to control the commercial use of that identity. *Waits v. Frito-Lay*, 978 F.2d 460, 1098 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080 (1993).

[T]he legislative history of section 114 indicates the express intent of Congress that "[t]he evolving common law rights of privacy, publicity, and trade secrets . . . remain unaffected [by the preemption provision] as long

as the causes of action contain elements, such as an invasion of personal rights . . . that are different in kind from copyright infringement." H.R. Rep. No 1476, 94th Cong., 2d Sess. 1321, reprinted in 1976 U.S.C.C.A.N. 5659, 5748.

A misappropriation claim does not create "vague borderline areas" between state and federal law as Petitioner asserts when Congress has expressly noted which types of claims will not be preempted.

B. NO CONFLICT EXISTS AMONG THE FEDERAL CIRCUIT COURTS OF APPEALS BECAUSE MISAPPROPRIATION IS A DISTINCT AND SEPARATE CAUSE OF ACTION OUTSIDE OF THE SUBJECT MATTER CONTEMPLATED BY SECTION 106 OF THE COPYRIGHT ACT.

Collectibles misstates the facts of this case and misstates the authority it cites in its effort to argue that misappropriation claims are preempted or subsumed by the Copyright Act. Petitioner blatantly attempts to mislead the Court into believing that the Respondents' names and/or likenesses appear in the copyrighted works. Pet. p. 23.

Nothing could be further from the truth. None of the Respondents' names or likenesses are included in the copyrighted works. Respondents' copyrights only covered the words and music. Reliance on the *Baltimore Orioles Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987), is completely misplaced. In *Baltimore Orioles*, the copyrighted material was the images and visual performances

of the baseball players. Does Collectibles believe that if the *Baltimore Orioles* case involved a copyrighted soundtrack of bats hitting balls and players sliding into base where none of the players' names or pictures were part of the soundtrack that Collectibles would be free to misappropriate the players' images and names for the purpose of marketing its soundtrack? Not hardly.

Likewise, *Allison v. Vintage Sports Plaques,* 136 F.3d 1443 (11th Cir. 1998) is completely inapposite. In *Allison,* the copyrighted property was the likeness of the person involved. Collectibles' argument that these cases are instructive and evidence a conflict among the circuits demonstrates the invalidity of Collectibles' arguments.

Copyright protection extends to "original works of authorship fixed in any tangible medium of expression" 17 U.S.C. § 102(a).

Section 102 clearly sets forth the subject matter of copyright.

> (A) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or a device. Works of authorship include the following categories:
>
> (1) literary works;
>
> (2) musical works, including any accompanying words;
>
> (3) dramatic works, including any accompanying music;

(4) pantomimes and choreographic works;

(5) pictorial, graphic, and sculptural works;

(6) motion pictures and other audiovisual works;

(7) sound recordings; and

(8) architectural works.

17 U.S.C.A. § 102(a).

Section 102 is silent on the protection of the 'persona' of the author or creator of the works. A person's name and likeness are not mentioned and are not given protection under the Act. The Act makes no further provision expressly granting protection once the name or likeness is incorporated into the work.

In *Midler v. Ford Motor Co.*, 849 F.2d 460, 461 (9th Cir. 1988) the Court discussed the distinction between the protection of a work of authorship and something more personal. *Midler* involved an artist's claim of misappropriation of her vocal style. The court upheld her claim because it was a personal right not within the realm of the Copyright Act. The Court reasoned that a voice is "one of the most palpable ways identity is manifested". *Id.* at 463.

Likewise, Respondents are seeking the protection of a form of identity, even more personal than a voice. One's name and likeness are more closely associated with a human identity than is a voice.

Petitioners fail to meet the two-part preemption analysis set forth in *Daboub v. Gibbons*, 42 F.3d 285, 289 (5th

Cir. 1995) which requires that the cause of action fall within the general subject matter of the copyright law and whether it protects rights that are equivalent to any of the exclusive rights of the Copyright Act in 17 U.S.C. Section 106 which provide the owner of a copyright with "the exclusive rights to do and authorize any of the following:"

> (1) to reproduce the copyrighted work in copies or phonorecords;
>
> (2) to prepare derivative works based upon the copyrighted work;
>
> (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
>
> (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
>
> (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
>
> (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

17 U.S.C.A. § 106.

The statute grants the rights to reproduce, prepare derivative works, distribute, perform, display. Noticeably

absent from the list is any mention or contemplation of the rights to one's own persona. Collectibles does not even argue that the names, images and likenesses are included in the copyrighted materials for which copyright protection was claimed or granted.

Petitioners improperly argue that the availability of this separate cause of action under state law would undermine the intent of Congress in its attempt to eradicate the "dual system". Pet. p. 20. Yet, Petitioners take the contradictory stance that they do not assert that the Copyright Act preempts all claims of misappropriation yet they state that once it becomes fixed in a tangible medium of expression it becomes part of the subject matter of the Copyright Act. Pet. p. 14.

Petitioners would have this Court believe that upon the procurement of a copyright, one relinquishes personal rights to privacy or publicity. If this is so, the intent of Congress would be thwarted. This policy would discourage more seekers of a copyright than promote the dissemination of material.

CONCLUSION

The Fifth Circuit's decision does nothing more than pretermit the pickpocket mentality of Collectibles' petition. Collectibles infringed copyrights, now it wants to be excused for its damage to the Respondents' right of publicity and privacy. The misappropriated images and names were not part of the copyrighted material. If Collectibles wanted to use these valuable rights it should have obtained permission and paid for them. This case

raises no significant issues of copyright law that warrant this Court's review.

For all of the foregoing reasons, Respondents respectfully request that this Honorable Court deny the petition.

Respectfully submitted,

LAW OFFICES OF DAVID W. SHOWALTER
A Professional Corporation

DAVID W. SHOWALTER
Counsel of Record
CHARLOTTE FLOECK
5231 Bellaire Boulevard
Bellaire, Texas 77401
(713) 660-0491
(713) 660-0493 (FAX)

Attorneys for Respondents